

### REMARKS

The drawing figures and the specification have been amended to insert content from U.S. Patent No. 5,868,740, which was incorporated by reference into the subject application in paragraph 0041, lines 15-18, of the subject application. Accordingly, no new matter has been added (M.P.E.P. §§ 608.01(p) and 2163.07(b)).

#### I. OBJECTION TO THE DRAWINGS

The drawings stand objected to because the electrodes of claims 8, 9, 17, and 18 are not shown in the figures. The drawings and specification have been amended to overcome the drawing objection. In particular, Applicants note that figures 7 and 8 of the subject application, as amended, show electrodes 124, which may be considered as an example, or an embodiment, of the claimed electrodes of claims 8, 9, 17, and 18.

#### II. CLAIM REJECTIONS UNDER U.S.C. § 102

Claims 1-6 and 10 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,148,236 (Dann). Claims 1-6, 10-16, and 19-26 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,921,244 (Chen). Applicants respectfully note that in order to sustain a rejection under §102, each element in the rejected claim must be found, either expressly or inherently, in the cited reference.

##### Dann

Claim 1 recites a first elongate member comprising a distal end and a magnet carried by the distal end. Dann does not disclose or suggest such limitation. Rather, Dann discloses a probe 28

containing microwave antenna 30 for delivering microwave energy to treat tissue, and a transperineal needle 40 carrying seeds 46 (column 2, line 56 to column 3, line 23, and figure 2).

Neither the probe 28, nor the transperineal needle 40, carries a *magnet*, as recited in claim 1. For at least the foregoing reason, claim 1 and its dependent claims 2-6 and 10, are believed allowable over Dann.

Chen

Claim 1 also recites a source of energy for delivering energy to *heat* tissue within the target tissue region, the magnetic beads configured for *enhancing heating* of the tissue (Emphasis added). Chen does not disclose or suggest these limitations. Rather, Chen discloses a photodynamic therapy (PDT) probe 100 connected to a power supply 126, wherein the probe 100 has LEDs 102 for emitting light (column 5, lines 45-63, and figure 1). The light emitted from the LEDs 102 is used to interact with a photoreactive agent, which destroys tissue by photodynamic reaction (column 1, lines 38-63). As such, the probe 100 of Chen does not deliver energy to *heat* tissue. Also, in Chen, magnetic particles 116 are mixed in the photoreactive agent to prevent the agent from migrating to healthy tissue (column 5, line 64 to column 6, line 41). As such, the magnetic particles 116 of Chen does not enhance heating of tissue. For at least the foregoing reasons, claim 1 and its dependent claims 2-6 and 10, are believed allowable over Chen.

Claim 11 recites delivering energy to heat tissue within the target tissue region, the magnetic beads enhancing heating of the tissue. Claim 20 recites a similar limitation. As discussed with reference to claim 1, Chen does not disclose or suggest heating tissue, even less, using magnetic beads to enhance heating of the tissue. For at least the foregoing reasons, claims 11 and 20, and their respective dependent claims 12-16, 19, and 21-26, are believed allowable over Chen.

III. CLAIM REJECTIONS UNDER U.S.C. § 103

Claims 11-16 and 19-26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dann in view of Chen.

Claim 11 recites generating a magnetic field within the target tissue region to cause migration of the beads. Claim 20 recites a similar limitation. According to the office action, it would have been allegedly obvious to modify Dann (which does not disclose or suggest migration of beads) to use a magnetic field to migrate the beads, as taught in Chen. Applicants respectively traverse.

Applicants respectfully submit that the motivation to combine Dan and Chen is not present. To establish a case of obviousness under 35 U.S.C. § 103, there must be some motivation to combine the teaching of the references. (M.P.E.P. 706.02(j)). Furthermore, the fact that the references can be combined or modified is not sufficient to establish prima facie obviousness. (M.P.E.P. 2143.01). Rather, the prior art must suggest the desirability of the claimed invention. (M.P.E.P. 2143.01).

In this case, Dann teaches fixedly implanting a cartridge 44 (containing seeds 46) at a location that is away from probe 28 (i.e., at an outer capsule of prostate 14) (column 3, lines 48-54, and figure 2). Such configuration ensures tissue that is further away from the probe 28 and that is not treated by the probe 28 can be treated using the seeds 46 (column 3, lines 24-65). On the other hand, Chen teaches including magnetic particles in photoreactive agent such that the position of the agent can be controlled magnetically without the agent migrating to healthy tissue (column 6, lines 17-41). As such, Chen is completely unrelated to the teaching of Dann, and there is no motivation to modify Dann such that the seeds 46 in Dann can be migrated using a magnetic field.

According to the office action, it would have been allegedly obvious to modify Dann to use a magnetic field to migrate the beads because “this would provide a greater concentration of the

magnetic beads in the treatment region allowing for a more effective treatment by applying more of the heating to the only desired treatment area.” Applicants respectively traverse. As discussed, because Dann specifically teaches confining the seeds 46 using the cartridge 44, and implanting the cartridge 44 such that the seeds 46 are spaced away from the probe 28, Dann actually teaches away from migrating the seeds 46. In particular, Applicants respectfully note that if the seeds 46 of Dann were to be caused to migrate towards the probe 28, then the seeds 46 could not be used to treat tissue away from the probe 28, which would be contrary to Dann’s teaching. For at least the foregoing reasons, Applicants respectfully submit that a prima facie case for the § 103 rejection has not been established, and requests that the § 103 rejection of claims 11 and 20, and their respective dependent claims 12-16, 19, and 21-26, be withdrawn.

Applicants further note that claim 20, which recites generating a magnetic field within the target tissue region to cause the magnetic beads to migrate *towards a wall of the vessel*, and delivering energy into the target tissue region to heat tissue therein, the magnetic beads enhancing *heating of tissue adjacent to the vessel* (Emphasis added), is allowable over Dann, Chen, and their combination, for at least the reason that Dann, Chen, and their combination do not disclose or suggest these limitations.

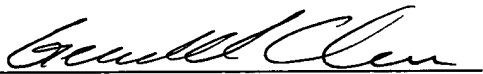
**CONCLUSION**

Based on the foregoing, all remaining claims are believed in condition for allowance. If the Examiner has any questions or comments regarding this amendment, please contact the undersigned at the number listed below.

Respectfully submitted,

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**AMENDMENT TO THE DRAWING FIGURE**

Please insert attached drawing sheet no. 4 (showing figures 7 and 8).